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BANNER & WITCOFF, LTD.			RICHER, AARON M	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/942,761	MCCARTHY ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	AARON M. RICHER	2628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 02 July 2009.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,2,4-11,33,34,36-39,46,48-50,52,53,55 and 57-68 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 68 is/are allowed.  
 6) Claim(s) 1,2,4-11,33,34,36-39,46,48-50,52,53,55 and 57-67 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed July 2, 2009 have been fully considered but they are not persuasive.
2. Applicant's arguments with respect to the art rejections of the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 58 and 59 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
5. Claim 58 recites a memory having instructions stored therein. However, MPEP 2106.01 states that " When functional descriptive material is recorded on some *computer-readable medium*, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" (emphasis added). The claim recites a memory storing instructions, but not a computer-readable medium, and so this claim is non-statutory.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1, 2, 6, 7, 11, 33, 34, 38, 39, 49, 53, 55, 57-59, 63, and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deo (U.S. Patent 5,973,612) in view of Vuoristo (U.S. Patent 6,603,969).

9. As to claim 1, Deo discloses a method comprising:  
receiving at a communication terminal a profile message (col. 2, lines 29-47; col. 10, lines 50-57; col. 13, lines 28-49; a sender specifies characteristics associated with how a terminal should alert a user to an incoming page);  
parsing the received profile message to identify a plurality of profile fields corresponding to terminal operating characteristics, wherein the profile message comprises at least two profile fields that correspond to any of the following: a ringing tone field, a ringing volume field, an incoming call alert field, a message alert tone field, a keypad tone field, a warning tone field, or a graphic field (col. 11, lines 25-51; fields

exist *corresponding to* a ringing tone as well as a visual, which could read on an “incoming call alert field” or a “graphic field”; col. 12, lines 1-45 disclose the parsing of fields and the examples following are examples of how those parsed fields are interpreted);

identifying a first user profile out of one or more user profiles stored in the communication terminal, wherein each of the user profiles corresponds to a set of user preferences and settings that control the operation of the communication terminal (col. 2, lines 29-47; col. 10, lines 50-57; col. 11, lines 14-18; col. 11, line 64-col. 12, line 15; a user sets up profiles that determine how a terminal should operate when certain objects are received).

Deo does not disclose storing the profile fields as a first user profile, and wherein upon selection of the user profile, configuring the terminal to operate according to the profile. However, Vuoristo discloses receiving user profiles from a remote station, identifying at least one of the profiles, and storing received profile fields as a profile in a mobile device (col. 8, line 35-col. 9, line 10; a user receives profiles with various fields from a remote location; the profiles can be identified for selection or changes, and selections or changes are stored as profile settings in the mobile device). Vuoristo also discloses a user selecting a first profile and configuring a mobile device to operate according to received profile fields associated with that profile (col. 10, lines 7-29). The motivation for treating profiles in this manner is to make it easier for users to change various characteristics associated with the mobile device (col. 2, lines 19-33). It would have been obvious to one skilled in the art to modify Deo to store received profile fields

and select profiles to change operating characteristics in order to make it easier for a user to change such characteristics as taught by Vuoristo.

10. As to claim 2, Deo discloses a method wherein the received plurality of profile fields includes a ringing tone and at least one graphical picture (col. 2, lines 48-56; audible alarm signals and melodies read on ringing tones, while a flashing indicator reads on a graphical picture).

11. As to claim 6, Deo discloses a method wherein the profile message is received from a remote server providing promotional content (col. 10, line 64-col. 11, line 5; a remote provider automatically sends information regarding stock events; given that the term "promotional content" is very broad, it can be read as any event that promotes a product, and in this case, it is stock that is being promoted).

12. As to claim 7, Deo discloses a method wherein the message is received from a remote server providing event driven content (col. 10, line 64-col. 11, line 5; a remote provider automatically sends information regarding stock events).

13. As to claim 11, Deo discloses a method wherein the profile message includes a profile name label for the plurality of profile fields corresponding to terminal operating characteristics (col. 8, lines 27-50; each group of characteristics has an associated "cap code" that labels the type of data being sent).

14. As to claim 33, see the rejection to claim 1. Vuoristo further discloses updating a set of preferences in a profile with received profile fields when they are received (col. 9, lines 37-47; a user can select services for a profile from a received set).

15. As to claim 34, see the rejection to claim 2.

16. As to claim 38, see the rejection to claim 6.
17. As to claim 39, see the rejection to claim 7.
18. As to claim 49, see the rejections to claims 1 and 33.
19. As to claim 53, see the rejection to claim 2.
20. As to claim 55, Deo discloses a method wherein configuring the communication terminal comprises creating a new user profile on the communication terminal based on the plurality of received profile fields (col. 10, lines 50-57; col. 11, lines 14-18; col. 11, line 64-col. 12, line 15; the combination of incoming characteristics and current set characteristics reads on a new profile).
21. As to claim 57, see the rejection to claim 55.
22. As to claim 58, see the rejection to claim 1.
23. As to claim 59, see the rejection to claim 2.
24. As to claim 63, Deo discloses a method wherein the plurality of profile fields comprises a first field identifier corresponding to a first data type, and a second field having a second field identifier corresponding to a second different data type (col. 12, lines 50-60).
25. As to claim 67, see the rejection to claim 63.
26. Claims 4, 8, 36, 46, 48, 50, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deo in view of Vuoristo and further in view of Smith (U.S. Patent 6,226,367).
27. As to claim 4, neither Deo nor Vuoristo discloses a method wherein the plurality of profile fields includes at least one of a card defining contact information and a

calendar note defining a date of an event. Smith, however, does disclose such information being stored (col. 10, lines 47-52; an electronic business card, or EBC, with contact information is stored). The motivation for this is to allow a user to take full advantage of caller ID and contacts functions (col. 2, lines 24-39). It would have been obvious to one skilled in the art to modify Deo and Vuoristo to store an electronic business card in order to enhance caller ID and contacts functions as taught by Smith.

28. As to claim 8, Smith discloses a method comprising providing a display on the communication terminal allowing the user to discard one of more of the terminal operating characteristics from a received profile message after inspecting the plurality of profile fields included in the profile message (col. 10, lines 47-52; an option for storing an EBC is presented; if a user chooses not to store an EBC, the EBC is not saved and therefore discarded). Motivation for the Deo- Vuoristo-Smith combination is given in the rejection to claim 4. It is noted that this feature further enhances the caller ID and contacts functions of a cellular phone/PDA/pager.

29. As to claim 36, see the rejection to claim 4.

30. As to claim 46, Smith discloses a method comprising:

after receiving the profile message, providing a display on the communication terminal to notify a user of the receipt of the profile message (col. 10, lines 40-52; characteristics such as an icon are displayed, alerting a user to new characteristics received);

and receiving at the communication terminal user input indicating that the received profile message is to be saved on the communication terminal (col. 10, lines

47-52; an option for storing an EBC is presented; if a user chooses not to store an EBC, the EBC is not saved and therefore discarded). Motivation for the Deo- Vuoristo-Smith combination is given in the rejection to claim 4. It is noted that this feature further enhances the caller ID and contacts functions of a cellular phone/PDA/pager.

31. As to claim 48, see the rejection to claim 46. Neither Deo nor Smith discloses that profiles are to be updated, but Park does disclose this as stated in the rejection to claim 33.

32. As to claim 50, see the rejection to claim 46.

33. As to claim 52, see the rejection to claim 8.

34. Claims 5, 9, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deo in view of Vuoristo and further in view of Park (U.S. Patent 7,158,805).

35. As to claim 5, neither Deo nor Vuoristo discloses that the plurality of profile fields includes bookmark information defining the location of a server document associated with a user-selectable profile. Park, however, discloses an update system with information such as a home page address (col. 9, see information item 10). It would have been obvious to one skilled in the art to modify Deo and Vuoristo discloses to include a server document address as received information as taught by Park as this is simply combining a new piece of information into the structure of Deo and Vuoristo. The inventions of Deo and Vuoristo would still perform the same way, but would display and store a document address instead of a tone, visual, or other operating characteristic. One skilled in the art would recognize this as keeping in the spirit of Deo's and Vuoristo's inventions, while substituting one piece of data for another.

36. As to claim 9, Park discloses a method of creating an animation associated with a user-selectable profile with a plurality of individual pictures (col. 9, see information item 16 “moving picture”). See the rejection to claim 5 for the rationale of the Deo-Vuoristo-Park combination. It is submitted that the same rationale applies to this claim, as an animation is just another piece of identifying data to be received.

37. As to claim 37, see the rejection to claim 5.

38. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Deo in view of Park and Vuoristo and further in view of Tran (U.S. Publication 2022/0069220).

39. As to claim 10, none of Deo, Vuoristo, and Park discloses producing a screen saver from an animation upon selection of a user-selectable profile. Tran, however, discloses a mobile terminal (p. 5, section 0060) that downloads news clips and animates them as a news ticker to be used when the mobile terminal is inactive, thus acting as a screen saver (p. 17, section 0142). It would have been obvious to one skilled in the art to modify Deo, Vuoristo, and Park to display a screen saver of received information as taught by Tran as this is simply combining pieces of data into an animation as is known in the art. The invention of Deo would still perform the same way, but would use icons or pictures in succession to create a screen saver instead of just displaying a single flashing indicator. One skilled in the art would recognize this as keeping in the spirit of Deo’s invention, while substituting one piece of data for another.

40. Claims 60-62 and 64-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deo in view of Vuoristo and further in view of Beaton (U.S. Patent 6,442,263).

41. As to claim 60, neither Deo nor Vuoristo expressly discloses using SMS messages as profile messages. Beaton, however, does disclose using SMS messages to transfer profile data, such as EBC (electronic business card) data (col. 11, lines 12-21). The motivation for using SMS in this manner is that SMS is an error-free, guaranteed delivery system for point-to-point messages (col. 4, line 58-col. 5, line 13). It would have been obvious for one skilled in the art to modify Deo and Vuoristo to use SMS to transfer profile information in order to guarantee delivery as taught by Beaton.

42. As to claim 61, Beaton discloses a method wherein the profile message comprises a plurality of concatenated SMS messages (col. 4, line 58-col. 5, line 13; profile messages too large for one SMS message can be concatenated into multiple messages).

43. As to claim 62, Beaton discloses a number of fields for EBC data (see fig. 18b for instance) in an SMS, but does not disclose how they would be separated. While the claim recites using “line feed characters” to separate, it is noted by examiner that there is no disclosed criticality in applicant’s specification to using such characters to separate fields. It is noted by examiner that the choice of a line feed character appears to be a matter or design choice and that the invention would perform just as well using some other character as a separation character.

44. As to claims 64-66, see the rejections to claims 60-62.

### ***Conclusion***

45. Claim 68 is allowed.

46. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON M. RICHER whose telephone number is (571)272-7790. The examiner can normally be reached on weekdays from 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kee Tung can be reached on (571) 272-7794. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron M Richer/  
Primary Examiner, Art Unit 2628  
11/8/09